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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/511,166

07/13/2005

Pascal Chenut

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7590

07/24/2008

YOUNG & THOMPSON

209 Madison Street

Suite 500

ALEXANDRIA, VA 22314

EXAMINER

MOHANDESI, JILA M

ART UNIT

PAPER NUMBER

3728

MAIL DATE

DELIVERY MODE

07/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/511,166	CHENUT ET AL.	
	Examiner	Art Unit	
	JILA M. MOHANDESI	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/14/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is are rejected under 35 U.S.C. 102(b) as being anticipated by Greenawalt (US 5,901,394). Greenawalt '394 discloses a modular proprioceptive orthopedic insole to re-establish and/or preserve the correct dynamic of walking or running, said insole (element 29 and rubber material 36) being made in an elastic material, comprising on its upper surface means (shock absorbing heel inset 13) for activating the articular receptors located between the talus and the calcaneus as soon as a step is habitually initiated by the heel, and means (arch support elements 31, 32, 33, 34) for guiding the foot when it becomes engaged on the physiological axis of

walking, and secondly on its undersurface it comprises at least one removable corrective element (element 28) able to provide abduction or adduction for respective deficient or excessive step initiation, and /or is able to correct a varus and /or valgus. See Figure 5 embodiment.

5. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Yung et al. (US 6,453,578). Yung discloses a modular proprioceptive orthopedic insole to re-establish and/or preserve the correct dynamic of walking or running, said insole (polymeric insole 30) being made in an elastic material, comprising on its upper surface means (shock absorbing heel pad 36) for activating the articular receptors located between the talus and the calcaneus as soon as a step is habitually initiated by the heel, and means (shock absorbing pad 34) for guiding the foot when it becomes engaged on the physiological axis of walking, and secondly on its undersurface the insole comprises at least one recess (38) positioned along the inner and/or outer edge of said insole in which a removable corrective element (insert 40) can be positioned that is made of more rigid element than the insole to provide abduction or adduction for respective deficient or excessive step initiation, and /or is able to correct a varus and /or valgus. See Figure 2 embodiment.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 5 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yung in view of Greenawalt (US 4,694,590). Yung as described above discloses all the limitations of the claims except for the removable elements on one of their surfaces comprising a male attachment member able to cooperated with female member positioned at the bottom of the recesses. Greenawalt '590 discloses removable elements where on one of their surfaces comprises a male attachment member able to cooperated with female member positioned at the bottom of the recesses for better securing the elements to the insole. Therefore, it would have been obvious to one skilled in the art at the time of the invention to provide the plurality of removable elements of Yung with cooperating male and female attachments as taught by Greenawalt '590 for better securement of the elements to the insole.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yung in view of Sessa Des. 389,996. Yung as described above discloses all the limitations of the claims except for on the underside of the insole including a channel of serpentine shape comprising regularly distanced holes leading to the upper surface of the insole so as to allow the evacuation of perspiration. Sessa discloses an insole wherein on the

underside of the insole includes a channel of serpentine shape comprising regularly distanced holes leading to the upper surface of the insole so as to allow the evacuation of perspiration. Therefore, it would have been obvious to one skilled in the art at the time of the invention to provide on the underside of the insole of Yung a channel of serpentine shape comprising regularly distanced holes leading to the upper surface of the insole as taught by Sessa so as to allow the evacuation of perspiration.

10. Claims 6-13, 15, 17 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yung in view of Patterson (US 6,176,025) and Greenawalt '394.

Yung as described above discloses all the limitations of the claims except for the specific number and shape of the removable elements. Patterson discloses that it is desirable to provide a plurality of removable elements with different shapes in recesses on the bottom surface of an insole to provide a cushioning system that provides improved cushioning in the areas of the insole that are subject to the greatest pressure. Greenawalt discloses an insole with plurality of removable elements on the top surface of the insole to custom made footwears incorporating orthotics. Therefore, it would have been obvious to one skilled in the art at the time of the invention to provide a plurality of removable elements with different shapes on the top and bottom surfaces of the insole of Yung and taught by Patterson and Greenawalt to custom make the insole and provide improved cushioning in the areas of the insole that are subject to the greatest pressures.

With respect to the shape and size of the removable elements, it would have been an obvious matter of design choice to modify the shape and size of the removable

elements, since such a modification would have involved a mere change in the size and shape of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955) and *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yung-Patterson-Greenawalt as applied to claims 6-13, 15, 17 and 18-19 above, and further in view of Legatzke (US 6,178,662). Yung as modified above discloses all the limitations of the claims except for the alveolar structure of the insole consisting of a honeycomb structure. Legatzke discloses an insole with a honeycomb structure to ventilate and cushion insoles. Therefore, it would have been obvious to one skilled in the art at the time of the invention to provide honeycomb structure to the insole of Yung as taught by Legatzke to cushion and ventilated the insole.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are orthopedic insoles analogous to the instant invention.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JILA M. MOHANDESI whose telephone number is (571)272-4558. The examiner can normally be reached on MONDAY-FRIDAY 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey YU can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JILA M MOHANDESI/
Primary Examiner, Art Unit 3728

JMM
July 21, 2008